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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,903	07/28/2003	Linda C. Uhler-Tsang	100202582-1	7437

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT PAPER NUMBER

1755

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,903

Applicant(s)

UHLIR-TSANG ET AL.

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/28/03, 7/19/04 & 12/20/04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed December 20, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

Applicants should note that there were no copies of any of the EP references on the IDS filed December 20, 2004. Accordingly, they have not been considered. The examiner will consider these references if applicants supply a copy in response to this Office Action.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: no literal antecedent basis is seen in the specification for the following phrase: "wherein said carboxylic acids are mono- or polycarboxylic acids having 20 carbons or less" in claims 3, 10 and 17 (page 6, lines 5 and 6 of the specification only describe acetic, adipic and succinic acids). It is the examiner's position that these three acids do not provide antecedent basis for "having 20 carbons or less" as claimed.

The examiner suggests the incorporation of this phrase into the specification or the claims amended accordingly.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7, 8, 10-16, 19, 20 and 22-24 of copending Application No. 10/870,844 (US 2005/0025915).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukumoto et al.

Fukumoto et al. teach an ink jet ink composition having a pH of 8-10.5 comprising an aqueous medium such as a mixture of water and a water-soluble organic solvent, 0.1-10 wt% of a cyan dye such as Direct Blue 199 and 0.1-10 wt% of an anti-bronzing additive comprising an aromatic compound having a carboxyl group and/or a salt thereof such as 2-naphthoic acid ($pK_a=4.17$). Fukumoto et al. further teach an ink jet printing method comprising ejecting the above ink composition onto a recording medium such as gloss-type recording medium (i.e. acidic recording medium with ink-receiving layer). See paras. 0019-0029, paras. 0037-0039, para. 0044, paras. 0051-0052, para. 0058, para. 0062, paras. 0064-0069, para. 0072, para. 0074, para. 0076, para. 0088, para. 0090, Table 1-1; examples 1, 8 and 9, para. 0098 and claims 1, 8, 9, 12, 13, 15, 23, 25 and 26. The ink jet ink composition as taught by Fukumoto et al. appears to anticipate the present claims.

The only limitations in the claims not found by the examiner are (1) wherein the print media has an alumina and/or silica-based coating and (2) wherein the anti-bronzing additive has a pK_a value that is 1 until below that of the dye. However, these limitations are considered inherent because there does not appear to be any reason why the cited reference would not contain an ink jet ink and ink system with applicants

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claimed print media and pKa value of the anti-bronzing additive since the substrate in the above reference is a glossy photographic paper and the cyan dye is Direct Blue 199 which are both preferred components as disclosed by applicants in the specification.

7. Claims 1-6, 8-13 and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Adamic et al.

Adamic et al. teach an ink jet ink composition comprising 0.5-20 wt% of a dye of the formula as disclosed, up to 30 wt% of an organic solvent, 0.1-5 wt% of a buffer having a pKa of 6.5-10 such as triethanolamine or tris[hydroxymethyl]aminomethane to maintain the pH in the range of 7-9.5 and to eliminate bronzing, 0.005-0.5 wt% ammonium phosphate (pKa=6.82) and water. Adamic et al. further teach an ink jet printing method comprising ejecting the above ink composition onto a recording medium such as Gilbert Bond paper (i.e. acidic recording medium with ink-receiving layer). See col. 2, lines 55-65, col. 3, lines 55-60, col. 4, lines 39-55, col. 5, lines 3-16 and lines 42-55, col. 7, lines 67-68, Table IV and claims 9, 17 and 22. The ink jet ink composition as taught by Adamic et al. appears to anticipate the present claims.

The only limitation in the claims not found by the examiner is wherein the print media has an alumina and/or silica-based coating. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain an ink jet ink and ink system with applicants claimed print media since the substrate in the above reference is a Gilbert Bond paper (i.e. glossy photographic paper) which is a preferred substrate as disclosed by applicants in the specification.

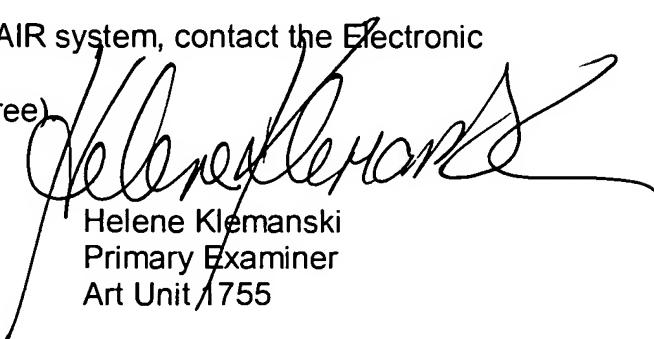
Conclusion


The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Helene Klemanski
Primary Examiner
Art Unit 1755


HK
June 25, 2005